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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/756,885

01/09/2001

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018563-002400US

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02/27/2009

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EXAMINER

NAJARIAN, LENA

ART UNIT

PAPER NUMBER

3686

MAIL DATE

DELIVERY MODE

02/27/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

7
8 *Ex parte* MUHAMMAD CHISHTI, KENNETH VARGHA,
9 and JOE BREELAND
10

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12 Appeal 2008-4117
13 Application 09/756,885
14 Technology Center 3600
15

16
17 Decided:¹ February 27, 2009
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19

20 *Before* MURRIEL E. CRAWFORD, HUBERT C. LORIN, and BIBHU R.
21 MOHANTY, *Administrative Patent Judges*.

22
23 CRAWFORD, *Administrative Patent Judge*.
24

25 DECISION ON APPEAL

26
27 STATEMENT OF THE CASE

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

1 Appellants appeal under 35 U.S.C. § 134 (2002) from a Final
2 Rejection of claims 1 to 30 and 46 to 59. We have jurisdiction under 35
3 U.S.C. § 6(b) (2002).

4 Appellants invented a method for distributing patient referrals
5 (Specification 1).

6 Claim 1 under appeal reads as follows:

7
8 1. A method for referring patients to
9 practitioners, said method comprising:
10 certifying a group of practitioners to perform
11 a medical procedure;
12 identifying individual patients who wish to
13 receive the procedure;
14 accessing an electronic database having
15 information comprising a number of procedures
16 performed by each of the group of certified
17 practitioners; and
18 providing to the identified individual patients
19 a list of certified practitioners, selected from the
20 electronic database, wherein those practitioners
21 who have performed more procedures than others
22 of the practitioners are placed preferentially on the
23 list.
24

25 The Examiner rejected claims 1 to 5, 12, and 13 under 35 U.S.C. §
26 103(a) as being unpatentable over DeBruin-Ashton in view of Falchuk and
27 Tawil.

28 The Examiner rejected claims 6 to 11 under 35 U.S.C. § 103(a) as
29 being unpatentable over as being unpatentable over DeBruin-Ashton in view
30 of Falchuk, Tawil and Kurzius.

31 The Examiner rejected claims 14, 16 to 19, 21, 22, 29 and 30 under 35
32 U.S.C. § 103(a) as being unpatentable over DeBruin-Ashton in view of Joao.

1 The Examiner rejected claim 15 under 35 U.S.C. § 103(a) as being
2 unpatentable over DeBruin-Ashton in view of Joao and Tawil.

3 The Examiner rejected claim 20 under 35 U.S.C. § 103(a) as being
4 unpatentable over DeBruin-Ashton in view of Joao and Falchuk.

5 The Examiner rejected claims 23 to 28 under 35 U.S.C. § 103(a) as
6 being unpatentable over DeBruin-Ashton in view of Joao, Tawil and
7 Kurzius.

8 The Examiner rejected claims 46 to 49, 51, 52, 55, 56 and 58 under 35
9 U.S.C. § 103(a) as being unpatentable over Tawil in view of Falchuk.

10 The Examiner rejected claims 50 and 59 under 35 U.S.C. § 103(a) as
11 being unpatentable over Tawil in view of Falchuk and DeBruin-Ashton.

12 The Examiner rejected claims 53, 54 and 57 under 35 U.S.C. § 103(a)
13 as being unpatentable over Tawil in view of Falchuk and Kurzius.

14 The prior art relied upon by the Examiner in rejecting the claims on
15 appeal is:

16 Tawil	US 5,225,976	Jul. 06, 1993
17 DeBruin-Ashton	US 6,014,629	Jan. 11, 2000
18 Joao	US 2002/0032583 A1	Mar. 14, 2002
19 Kurzius	US 6,385,620 B1	May 7, 2002
20 Falchuk	US 2002/0152096 A1	Oct. 17, 2002

22 ISSUES

23 Have Appellants shown that the Examiner erred in finding that the
24 prior art discloses or suggests a method comprising the step of providing to
25 the identified individual patients a list of certified practitioners, selected
26 from an electronic database, *wherein those practitioners who have*

1 performed more procedures than others of the practitioners are placed
2 preferentially on the list?

3 Have the Appellants shown that the Examiner erred in finding that the
4 prior art discloses or suggest a method comprising the step of providing to
5 the identified individual patients a referral lists of certified practitioners,
6 selected from the electronic database, *wherein individual practitioners are*
7 *preferentially placed on the referral lists based on one or more performance*
8 *criteria?*

FINDINGS OF FACT

FF1. Appellants disclose a method of referring patients to practitioners for the performance of a new procedure (Specification 1). An object of Appellants' invention is to avoid over loading relatively inexperienced practitioners who might otherwise benefit from additional time and patient experience to develop skills in the new procedure (Specification 1). The Appellants disclose that a group of practitioners are first certified to perform the new procedure and the identification and contact information are collected and placed on a referral directory (Specification 8). The referral directory is periodically updated as additional practitioners are certified or removed. Performance criteria such as number of procedures will also be updated over time as practitioners gain experience (Specification 8). The method relies on preferential referral of certified practitioners based on the number of procedures that the practitioner has performed (Specification 8). Appellants disclose that tiers of levels within the referral directory are created based on the number of procedures

1 performed by the practitioners (Specification 9). In this regard, the
2 practitioners with the most experience are placed in a higher tier and referred
3 the greatest number of patients (Specification 9).

4 FF 2. DeBruin-Ashton discloses a method of referring patients to
5 practitioners (col. 1, ll. 36 to 39). This includes the step of providing a list
6 of practitioners from a practitioner database (col. 6, ll. 56 to 62). In the
7 DeBruin-Ashton method, the patient may be provided a list of practitioners
8 sorted by geographic area and specialty (col. 11, l. 19 to col. 12 l. 3). The
9 method includes a step to reduce the number of practitioners listed to a
10 threshold number (col. 12, ll. 32 to 36). This reduction step may include a
11 random selection process to ensure that all practitioners are on average listed
12 on an equal number of referral lists (col. 12, ll. 43 to 47). Alternately, other
13 selection algorithms may be used for reducing the number of practitioners
14 such as applying weighting factors to the selection process such that
15 physicians who have newly joined the service plan are represented in higher
16 proportion than practitioners that have been with the plan for an extended
17 period of time (col. 12 , ll. 47 to 54). De-Bruin-Ashton does not disclose
18 placing practitioners that have performed more procedures than others
19 preferentially on the list.

20 FF 3. Tawii discloses an automated health benefit processing system
21 (col. 1, l. 1). The system includes a database which includes background
22 information concerning each practitioner such as medical specialty, board
23 certification, number of years in practice, medical degrees with class rank,
24 residency location, number of malpractice suits lost and number of times the
25 practitioner has performed a procedure within a given amount of time (col.

1 3, ll. 3 to 18. The database can be sorted by individual medical procedure
2 (col. 3, ll. 19 to 25). Tawaii does not disclose placing practitioners that have
3 performed more procedures than others preferentially on a referral list.

4 FF 4. Falchuk discloses a medical consultation management system
5 (col. 1, l. 1). The system includes a database of certified practitioners
6 [paragraphs 0021, 0030]. Falchuk does not disclose placing practitioners
7 that have performed more procedures than others preferentially on a referral
8 list.

9 FF 5. Kurzius discloses a method for management of candidate
10 recruiting information that includes a candidate proficiency form that may
11 indicate both years of experience in a particular skill and a proficiency level
12 chosen from a select list of terms such as beginner, intermediate, full-
13 understanding and expert (col. 17, ll. 35 to 52). While Kurzius discloses that
14 the candidate can rate themselves in tiers of beginner, intermediate, full-
15 understanding or expert in skill areas, there is no disclosure that the tiers
16 relate solely to the of number times the candidate has performed the skill.
17 Kurzius does not disclose placing candidates that have performed the skill
18 more times than others preferentially on a list. Kurzius does not relate to
19 medical practitioners and thus discloses nothing about the number of times a
20 practitioner has performed a procedure.

21 FF 6. Joao discloses dental and oral surgery training and a database
22 containing statistical information such as treatment success rates and
23 information on the treatment providers (paragraphs 159 and 161). Joao does
24 not disclose placing candidates that have performed the skill more times than
25 others preferentially on a referral list.

1 PRINCIPLES OF LAW

2 The test for obviousness is what the combined teachings of the
3 references would have suggested to one of ordinary skill in the art. *See In re*
4 *Kahn*, 441 F.3d 977, 987-88 (Fed. Cir. 2006); *In re Young*, 927 F.2d 588,
5 591 (Fed. Cir. 1991) and *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).
6

7 ANALYSIS

8 *Obviousness of claims 1 to 5, 12 and 13*

9 We will not sustain the Examiner's rejection of these claims because
10 the cited prior art does not disclose a method including the step of providing
11 to the identified individual patients a list of certified practitioners, selected
12 from an electronic database, *wherein those practitioners who have*
13 *performed more procedures than others of the practitioners are placed*
14 *preferentially on the list* as is required by claim 1 from which claims 2 to 5,
15 12 and 13 depend. Although the Examiner is correct that DeBruin-Ashton
16 discloses a step of using a selection algorithm that applies weighting factors
17 to the selection process there is no disclosure that practitioners that have
18 performed more procedures are placed preferentially on a list. In fact,
19 DeBruin discloses that practitioners are listed so that they are all placed
20 equally on lists in such a fashion that the new practitioner who would
21 presumably have less experience are preferential placed lists (FF 2). While
22 Tawil discloses that the database may include information about the number
23 of procedures performed by each practitioner, there is no disclosure that
24 there is a practitioner list that is ordered so as to give the practitioners who

1 have performed the procedure more often a preferential place on the list.

2 Falchuk does not cure the deficiencies of DeBruin-Ashton and Tawil.

3 In view of the foregoing, we will not sustain the Examiners rejection
4 of claims 1 to 5, 12 and 13 under 35 U.S.C. § 103 as being unpatentable over
5 DeBruin-Ashton, Falchuk and Tawil.

6 Obviousness of claims 6 to 11

7 Claims 6 to 11 depend from claim 1. As noted in the proceeding
8 section, De-Bruin-Ashton, Falchuk and Tawil do not disclose the subject
9 matter of claim 1 related to the step of placing practitioners who have
10 performed more procedures preferentially on a list. Kurzius discloses a
11 candidate proficiency form but does not disclose that the candidates are
12 listed in accordance with the proficiency much less that practitioners are
13 placed preferentially on a list. As such we will not sustain the Examiner's
14 rejected of claims 6 to 11.

15 Obviousness of claims 14, 16 to 19, 21 to 22, 29 and 30

16 Claim 14 requires that the step of providing a referral lists of certified
17 practitioners, selected from an electronic database, *wherein individual*
18 *practitioners are preferentially placed on the referral lists based on one or*
19 *more performance criteria.* The Examiner relies on DeBruin-Ashton for
20 teaching forming a referral list based on one or more performance criteria
21 (Answer 9). While DeBruin-Ashton does disclose using a selection
22 algorithm to reduce the number of practitioners referred so that practitioners
23 that have been with the program for a shorter length of time are placed on a
24 list in higher proportion, DeBruin-Ashton does not disclose that the
25 practitioners are placed on the list in accordance with one or more

1 performance criteria. In this regard, we note that DeBruin-Ashton does not
2 disclose that the length of time with the program is related to a performance
3 criteria. Joao does not cure this deficiency.

4 In view of the foregoing, we will not sustain this rejection.

5 Obviousness of claim 15

6 Claim 15 depends from claim 14. As noted above neither DeBruin-
7 Ashton nor Joao discloses that practitioners are preferentially placed on a
8 referral list based on one or more performance criteria. While Tawil
9 discloses that the database may include information about the number of
10 procedures performed by each practitioner, there is no disclosure that
11 practitioners are placed on a list based on one or more performance criteria.

12 Therefore, we will not sustain the Examiner's rejection of claim 15.

13 Obviousness of claim 20

14 Claim 20 depends from claim 14. As stated above, neither DeBruin-
15 Ashton nor Joao disclose or suggest the subject matter of claim 14. Falchuk
16 does not cure the deficiencies of DeBruin-Ashton and Joao.

17 Therefore, we will not sustain the Examiner's rejection of claim 20.

18 Obviousness of claims 23 to 28

19 Claim 23 depends from claim 14. As stated above, neither DeBruin-
20 Ashton, Joao nor Tawil disclose or suggest the subject matter of claim 14.
21 While Kurzius discloses a candidate proficiency form that includes
22 information about the experience and skill level of the candidate, Kurzius
23 does not disclose that the candidates are preferentially listed based on the
24 experience and skill level much less on one or more performance criteria.

1 Therefore, we will not sustain the Examiner's rejection of claims 23 to
2 28.

3 Obviousness of claims 46 to 49, 51, 52, 55, 56 and 58

4 Claim 46 from which claims 47 to 49, 51, 52, 55, 56 and 58 depend,
5 includes language similar to claim 1 i.e., the step that practitioners are
6 prioritized on a list based on the number of times each practitioner has
7 performed the procedure. As we stated and found above, neither Tawil nor
8 Falchuk discloses a method that includes a step of prioritizing a
9 practitioner's position on a list based on the number of times the practitioner
10 performed a procedure.

11 Therefore, we will not sustain this rejection.

12 Obviousness of claims 50 and 59

13 Claims 50 and 59 are dependent on claim 46. As we have stated
14 above, neither Tawil, Falchuk nor DeBruin-Ashton disclose that a
15 practitioner is prioritized on a list based on the number of times the
16 practitioner has performed a procedure. Therefore, we will not sustain this
17 rejection.

18 Obviousness of claims 53, 54 and 57

19 Claims 53, 54 and 57 depend from claim 46. As we have stated
20 above, neither Tawil disclose that a practitioner is prioritized on a list based
21 on the number of times the practitioner has performed a procedure. In
22 addition, Kurzius discloses a candidate proficiency form but does not
23 disclose that the candidates are listed in accordance with the number of
24 times a practitioner has performed a procedure. Therefore, we will not
25 sustain this rejection.

1 CONCLUSION OF LAW

2 On the record before us, the Appellants have shown that the Examiner
3 erred in finding that the prior art discloses or suggests a method comprising
4 the step of providing to the identified individual patients a list of certified
5 practitioners, selected from an electronic database, wherein those
6 practitioners who have performed more procedures than others of the
7 practitioners are placed preferentially on the list.

8 On the record before us, the Appellants have shown that the Examiner
9 erred in finding that the prior art discloses or suggest a method comprising
10 the step of providing to the identified individual patients referral lists of
11 certified practitioners, selected from the electronic database, wherein
12 individual practitioners are preferentially placed on the referral lists based on
13 one or more performance criteria.

14
15 DECISION

16 The Examiner's rejection of claims 1 to 30 and 46 to 59 is reversed.

17
18 REVERSED

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22 hh

23
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